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PATENT
DOCKET NO.: 11220/129

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.: 09/879,217

Confirmation No. 6207

Applicant: Danenberg, Kathleen D.

Filed: June 13, 2001

Art Unit: 1637

Examiner: Jeffrey Fredman

For: METHOD OF DETERMINING
DIHYDROPYRIMIDINE DEHYDROGENASE
GENE EXPRESSION

Customer No. 23838

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE AND SUBMISSION OF TERMINAL DISCLAIMER

03/07/2005 SZEWDIE1 00000146 110600 09879217
Sir:
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This is in response to the Office Action dated February 16, 2005 setting forth a shortened statutory three-month period for response. Accordingly, this response is due on or before May 16, 2005.

Remarks begin on page 2 of this paper.

An **Appendix** including a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection over a Pending "Reference" Application and a Statement Under 37 CFR 3.73(b) is attached following page 2 of this paper.

REMARKS

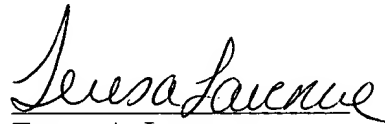
Applicant submits herewith a Terminal Disclaimer over copending U.S. Application No. 09/842,111 and a Statement Under 37 CFR 3.73(b). Since the only rejection in the Action was an obviousness-type double patenting rejection over copending Application No. 09/842,111, the Terminal Disclaimer is believed to obviate the sole rejection and place the above-identified application in condition for allowance. Allowance is respectfully requested.

The Office is hereby authorized to charge any fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Kenyon & Kenyon Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned at 202-220-4258 to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON

Date: 3/3/05



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**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING
REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)
11220/129

In re Application of: Kathleen D. Danenberg

Application No. 09/879,217

Filed: June 13, 2001

For: Method of Determining Dihydropyrimidine Dehydrogenase Gene Expression

The owner*, Response Genetics, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number 09/842,111, filed on April 26, 2001, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that: any such patent: granted on the pending **reference** application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☒ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney of record. Reg. No. _____

Signature

Date

Eric Alcorn

Typed or printed name

323/224-3900

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO